

31 JAN 2007



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| In re Application of                   | : |          |
| Lhote et al.                           | : |          |
| Application No.: 10/564,366            | : | DECISION |
| PCT No.: PCT/CA04/02080                | : |          |
| Int. Filing Date: 06 December 2004     | : | ON       |
| Priority Date: 16 December 2003        | : |          |
| Attorney Docket No.: 6222.480          | : | PETITION |
| For: Apparatus And Method For Pressure | : |          |
| Relief In An Exhaust Brake             | : |          |

This is in response to the petition under 37 CFR 1.47(a) filed on 10 July 2006.

### **BACKGROUND**

This international application was filed on 06 December 2004, claimed an earlier priority date of 16 December 2003, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 30 June 2005. The 30 month time period for paying the basic national fee in the United States expired at midnight on 16 June 2006. Applicants filed *inter alia* the basic national fee on 12 January 2006.

On 11 May 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration compliant with 37 CFR 1.497(a) and (b), indicating that the "signature of the first inventor is missing Mr. Andre F. Lhote from the declaration filed."

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), petitioner indicates that "the requisite fee is attached hereto," but payment of the \$200.00 petition fee is not currently reflected in the electronic records of the USPTO. Therefore, the petition fee is being charged to counsel's Deposit Account No. 50-0548, as authorized by the petition.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Andre Lhote be excused because he allegedly refused to sign the declaration. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

In support of the proposition that Mr. Lhote has refused to execute the declaration, counsel has provided evidence including a "Declaration of William C. Schrot..." Atty. Schrot refers to attached copies of letters sent to Mr. Lhote on 30 May 2006, 21 June 2006 and 05 July 2006, each of which indicates that a declaration and copy of the application are being sent and each of which requests execution and return of the declaration. However, it is not clear which (if any) of these letters were sent to Mr. Lhote's "last known address," in view of (1) the absence of an explicit statement of Mr. Lhote's last known address, and (2) the indication that the address on one parcel was corrected to 4992 Byrne Rd. Clarification as to whether any of the letters were sent to Mr. Lhote's "last known address" is required. Atty. Schrot also refers to Exhibit H, a copy of an e-mail from Ryan Marander to Joe Berenato indicating that

We have now had a response from Andre Lhote regarding a copy of a declaration for his signature as co-inventor for Pacbrake's Pressure Relief Brake US patent application. This is your reference number 6222.480. Andre returned the express package you originally sent to him on May 30, 2006 and gave it to Cathy Hailey,

Pacbrake's purchasing manager. When Andre Lhote handed the package to Cathy his words were, "I can't sign this."

As stated in the excerpt from MPEP 409.03(d) *supra*, "the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted." In view of this practice, a statement from Cathy Hailey would be appropriate. For all of the reasons described, it would not be appropriate to conclude at this time that Andre Lhote has "refused" to execute the application within the meaning of 37 CFR 1.47(a); as such, requirement (2) has not been satisfied.

Regarding requirement (3), the petition does not appear to include an explicit statement of the last known address of Mr. Lhote. Though the "Declaration of William C. Schrot..." refers to a "corrected address," the petition does not clearly indicate whether this address, or some other address, is the "last known address." Accordingly, requirement (3) has not been satisfied.

Regarding requirement (4), the declaration filed on 12 January 2006 has been signed by joint inventors Vincent Meneely, Gabriel Gavril, Tamara Spence and John Hartley on behalf of themselves and non-signing joint inventor Andre Lhote. This declaration is acceptable for purposes of compliance with 37 CFR 1.47(a) and 37 CFR 1.497(a) and (b). Therefore, requirement (4) has been satisfied.

### **DECISION**

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

The \$200.00 petition fee is being charged to counsel's Deposit Account No. 50-0548.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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